

### **REMARKS**

Applicants and Applicants' attorney express appreciation to the Examiner for the courtesies extended during the recent interview held on October 6, 2004. The amendments and arguments presented in this paper are consistent with the proposed amendments and arguments discussed during the Interview. Claims 1-22 are pending, of which claims 1 and 10 are independent method claims and claim 21 is an independent computer program product claim. As indicated above, claims 1, 10, and 21 have been amended by this paper.<sup>1</sup>

The Office Action rejected claim 21 under 35 U.S.C. § 101 as being directed to non-statutory subject matter because claim 22 recites that the one or more computer-readable media of claim 21 comprise physical storage media, which renders claim 21 non-statutory when the one or more computer-readable media are interpreted as non-physical. Applicants respectfully disagree. Paragraph [0023], for example, indicates that computer-readable media may comprise physical storage media, such as RAM, ROM, EEPROM, CD-ROM or other optical disk storage, magnetic disk storage or other magnetic storage devices, whereas paragraph [0024] indicates that computer-readable media may comprise a communications connection. Therefore, the limitation "physical storage media" in claim 22 is used in contrast to a communications link, rather than "non-physical" storage media as asserted in the Office Action. Accordingly, Applicants respectfully submit that the rejection of claim 21 under 35 U.S.C. § 101 as being directed to non-statutory subject matter is improper and should be withdrawn.

The Office Action rejected claims 3-4 and 16-20 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement because the claims contain subject matter that was not described in the specification in such a way as to reasonably convey to one of skill in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Claim 3 recites a "zero probability," claim 4 recites an "unknown zero probability," claims 16 and 18 recite an "executable file," claim 17 recites a "script file," and claims 19 and 20 recite the terms "common" and "different" which the Office Action asserts are not sufficiently taught or disclosed in the Specification.

As indicated above, paragraphs [0038] and [0043] have been amended to provide support in the Specification for claims 3-4 and 16-17. Applicants respectfully submit that paragraphs

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<sup>1</sup>Support for the amendments can be found throughout the Specification, and particularly in paragraphs [0010], [0033], [0034].

[0038] and [0043] in connection with the respect claims reasonably conveyed to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Amending paragraphs [0038] and [0043] simply represents a consolidation of the disclosure within the Specification, and therefore no new matter has been added. With respect to claims 19 and 20, the terms "common" and "different" refer to merging redundant (e.g., common) nodes disclose in paragraph [0045]. Here too, Applicants respectfully submit that paragraph [0045] in connection with claims 19-20 reasonably conveyed to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Accordingly, Applicants further respectfully submit that the rejection of claims 3-4 and 16-20 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement has been overcome and should be withdrawn.

With the exception of claims 3-4 rejected above, the Office Action rejected all pending claims under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,414,836 to Baer et al. ("*Baer*").<sup>2</sup>

Applicants invention, as claimed for example in independent method claim 1, relates to testing the functionality of the one or more software modules as executed on a computer system as the computer system interfaces with a projected use pattern, the one or more software modules capable of performing a plurality of standard functions. The method includes determining a plurality of projected use patterns, each based on information regarding how the one or more software modules will be used by different types of users; representing probability weights for at least one of the plurality of standard functions for each of the plurality of use patterns; selecting one of the plurality of projected use patterns for testing, the selected use pattern having a probability weight assigned to each of a plurality of standard functions that may be performed as the computer system interfaces with the selected projected use pattern; and determining a standard function to perform based on the probability weight corresponding to the standard function for the selected projected use pattern.

Applicants invention, as claimed for example in independent method claim 10, similarly relates to testing the functionality of one or more software modules as executed on A computer system as the computer system interfaces with one of a plurality of projected use patterns, the

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<sup>2</sup>Applicants do not acquiesce the asserted teachings of the cited art and specifically reserve the right to challenge any asserted teachings of the cited art in the future.

one or more software modules capable of performing a plurality of standard functions. the method includes determining a plurality of projected use patterns, each based on information regarding how the one or more software modules will be used by different types of users; representing probability weights for at least one of the plurality of standard functions for each of the plurality of use patterns; selecting one of the plurality of projected use patterns for testing, the selected use pattern having a probability weight assigned to each of a plurality of standard functions that may be performed as the computer system interfaces with the selected projected use pattern; generating an arbitrary value; comparing the arbitrary value to the probability weight, or a value derived from the probability weight, assigned to a particular standard function; and determining that the particular standard function is to be performed based on the comparison.

Applicants invention, as claimed for example in independent computer program product claim 21, also relates to testing the functionality of the one or more software modules as executed on a computer system as the computer system interfaces with one of a plurality of projected use patterns, the one or more software modules capable of performing a plurality of standard functions, the computer system representing probability weights for at least one of the plurality of standard functions. The computer program product includes computer executable instructions for determining a plurality of projected use patterns, each based on information regarding how the one or more software modules will be used by different types of users; computer-executable instructions for selecting one of the plurality of projected use patterns for testing, the selected use pattern having a probability weight assigned to each of a plurality of standard functions that may be performed as the computer system interfaces with the selected projected use pattern; computer-executable instructions for causing an arbitrary value to be generated; computer-executable instructions for comparing the arbitrary value to the probability weight, or a value derived from the probability weight, assigned to a particular standard function; and computer-executable instructions for determining that the particular standard function is to be performed based on the comparison.

In order to establish a *prima facie* case of obviousness, "the prior art reference (or references when combined) must teach or suggest all the claim limitations." MPEP § 2143 (emphasis added). During examination, the pending claims are given their broadest reasonable

interpretation, i.e., they are interpreted as broadly as their terms reasonably allow, consistent with the specification. MPEP §§ 2111 & 2111.01.

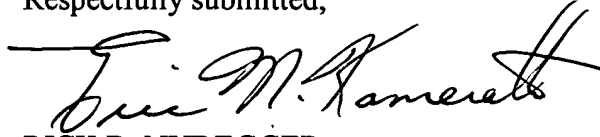
*Baer* discloses a data processing system that enables a user to generate test cases for exercising a program under test. Col. 3, ll. 3-5. The data processing system constructs a hybrid tree structure which generates the test cases. Col. 3, ll. 61-63. The hybrid tree structure includes attributes which enable traversals of various portions of the tree structure under control of a probability calculation. Col. 4, ll. 1-5. However, among other things, *Baer* fails to teach, suggest, motivate, determining a plurality of projected use patterns, each based on information regarding how one or more software modules will be used by different types of users, as recited in each of the pending independent claims. During the Interview, the Examiner concurred with this analysis and noted that the proposed amendment appears to overcome the prior art of record, and that upon receiving a formal response, the Examiner will give further consideration after performing an updated search.

Based on at least the foregoing reasons, therefore, Applicants respectfully submit that the cited art fails to anticipate or make obvious Applicants' invention, as claimed, for example, in independent claims 1, 10, and 26. Applicants note for the record that the other rejections and assertions of record with respect to the independent and dependent claims are now moot, and therefore need not be addressed individually. Accordingly, Applicants do not acquiesce to any assertions in the Office Action that are not specifically addressed above, and hereby reserve the right to challenge those assertions in the future, if necessary or desired.

In the event that the Examiner finds any remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney.

Dated this 16<sup>th</sup> day of December, 2004.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Eric M. Kamerath", with a stylized flourish at the end.

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